

DOCKET NO: 240302US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROYUKI KISO, ET AL. : EXAMINER: COONEY, J. M.
SERIAL NO: 10/618,693 :
FILED: JULY 15, 2003 : GROUP ART UNIT: 1711
FOR: CATALYST AND PROCESS FOR :
PRODUCING A RIGID POLYURETHANE
FOAM

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply Brief in reply to the Examiner's Answer dated July 13, 2007 (Answer). This Reply Brief will respond to the grounds of rejection in the order stated in the Corrected Appeal Brief, filed February 8, 2007 (Appeal Brief), rather than in the Answer, which addresses the grounds of rejection in the order of grounds (C), (A), and (B), respectively.

Applicants continue to maintain the arguments made in the Appeal Brief. The following is in reply to the Response to Argument (Answer at 7-12).

Grounds (A) and (B)

Since the Examiner treats these grounds together in the Answer (Answer at 8-12) in the response to the Appeal Brief, Applicants reply in kind below.

The Examiner, in effect, ignores the preambles of the present claims, on the ground that they are not claim limitations (Answer at 8-9).

In reply, if the rejections were ones of anticipation, Applicants would have no quarrel. However, the rejections are of obviousness, and while the preambles may not be claim limitations *per se*, nevertheless, they highlight the non-obviousness of the presently-claimed inventions. None of the applied prior art discloses or suggests any advantage from using the individually listed amine compound catalysts in combination for use even with the disclosed blowing agents in the applied prior art, let alone the blowing agents recited in the preambles of the present claims.

As to a statement of applicable precedent with regard to the issue of unexpected results, the Examiner simply copies statements of law and findings from the Final Rejection (Answer at 9-12), response to which has been presented in the Appeal Brief.

Interspersed in what the Examiner has copied from the Final Rejection are findings that the comparative data of record have not been made against “the prior art embodiment relied on/or the closest prior art,” and that a proper comparison would have been against “representative catalyst blends of the prior art embodiment relied upon” (Answer at 10-11).

In reply, the Examiner has never identified **any** prior art embodiment which he deemed to be the closest prior art or **any** representative catalyst blends. At least with regard to the particular amines within the terms of the present claims, there is no disclosure or suggestion in the applied prior art that any of these amines would provide superior results if combined, let alone in the particular combination required by the present claims. Applicants continue to maintain that the closest prior art is the use of the recited amine compounds alone.

For all the above reasons, Applicants continue to maintain the rejections under these Grounds should be REVERSED.

Ground (C)

In response to arguments in the Appeal Brief, the Examiner appears to find, in effect, that the claims are broad enough to include the improvement of any property while Applicants have only listed the properties of flowability, adhesive strength and dimensional stability, at page 12, lines 5-12 of the specification, and that the requirement that at least one of the properties be dimensional stability does not remedy this deficiency (Answer at 8).

In reply, with regard to Claim 1 and claims dependent thereon, and Claim 37, there can be no question that Applicants, as of the filing date, were in possession of an invention wherein amine compounds (1) and (2) were present in such amounts that dimensional stability of the recited rigid polyurethane foam is improved. In reality, that is all these claims require in terms of amounts of the components. If an improvement in dimensional stability does not occur with a particular composition of amine compounds (1) and (2), the composition is not within the terms of the claims, even if another property is improved.


With regard to Claim 38, which the Examiner has not treated separately, although it was argued separately in the Appeal Brief, there can be no question of possession of the invention as of the filing date, since the specific properties recited in this claim are those alluded to above and described in the specification at page 12, lines 5-12.

For all the above reasons, Applicants continue to maintain the rejection should be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Harris A. Pitlick

Registration No. 38,779

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)

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